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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,622	04/11/2001	John J. Potenza	SE001U	1826

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EXAMINER
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NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/832,622

Applicant(s)

POTENZA, JOHN J.

Examiner

Tan Dean Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-18 and 20-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-18 and 20-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

The amendment filed 9/22/03 has been entered.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-3, 5-16, 17-18, 20-30, 31-38, 39-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-3, 5-16, 17-18, 20-30, 31-38, 39-53 are directed to a "method for assisting in the management of a service provider", which is not within one of the classes of invention set forth in § 101.

The "method for assisting in the management of a service provider" comprising the steps of (a)-(c) {claims 1, 39}, steps (a)-(d) {claim 17}, steps (a)-(e) {claim 31}, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "method for assisting in the management of a service provider" comprising the steps of (a)-(d) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (computer/network) and are therefore are found to be non-statutory subject matter.

***Claim Rejections - 35 USC § 112***

3. Claims 1-3, 5-16, 17-18, 20-30, 31-38, 39-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims call for a method for assisting in the management of a service provider but the last step calls for the manager "may evaluate" which means "possible or likelihood of evaluating" or may not be required to evaluate which make the claim vague and indefinite. How does one assist the management wherein the evaluation of the service by the employee to the consumer may not be required? What is then the relationship between the "at least one employee" in the preamble of the claim to the "employee" at the last step. Deletion of the term "may" is required to overcome this rejection.

Claims 1, 31 and 39, steps (a) and (b) in these three independent claims are wordy and confused. The step of "obtaining data" from the service evaluator is critical and should be written in positive/active term.

Claims 8, 23 and 45 are wordy and confused.

Claim 17 step (a) with the repeated "an evaluation processor" and the language in line 2 is wordy and confused. The step of "assessing performance" from the service evaluator is critical and should be written in positive/active term.

Claims 2, 14-16, 18, 28-30, 32, 36-38, 40, 51-53 are written in passive/inactive state which are vague and confused for a method claims. Conversion of the claims language to positive/active state are recommended to improve clarity and overcome the rejections.

Claims 14-16 recites the limitation "the inquiry/response system" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3, 6-11, 13-16, 17-18, 20-25, 27-30, 31-33, 35-38, 39-48, 50-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KESEL (US Patent 6,026,387).

As for claims 1, 17, 31, KESEL discloses a method for assisting in the management of a service provider having at least one manager, at least one employee and at least one service evaluator, the method comprising the steps of: (a) service evaluator contacting an evaluation processor and providing evaluation data to the processor, (b) the valuation data containing a unique identifier of the service provider, and (c ) the processor provides correlated information from the evaluation data to the service provider manager (see col. 2, lines 1-15 (or 2:1-15), 2:25-30, 3:1-20, 4:43-67, 5:5-13, 5:50-67, 6:45-67, Table 2). Note that the term "may evaluate" has no patentable weight because it's considered at optional since it means that there is possibility or

likelihood that the manager may or may not evaluate the service by the employee.

Alternatively, Table 2 discloses the evaluation of the service of the provider, name of the person or department subject to the comment; therefore, it would have been obvious to evaluate the service of the person or salesperson if desired in view of the teaching of salesperson or department by KESEL. Note that ARTICLE 1992 discloses the application of statistical analysis to the data received from the consumer and providing correlating the normalized representation (col. 5, lines 65-67 (or 5:65-67), 6:63-67). The applying of other correlating issues in view of the general teaching using statistical analysis would have been obvious since statistical analysis normally involving correlation study.

As for claim 39, the regeneration of a report is taught on col. 4, lines 30-35, 60-65 or col. 5, lines 10-15. As for claims 2, 18, 32, 40, these are taught in col. 3, lines 1-15 and further in view of the responses by the management to the report (see 3:15-20). Note that the term "interactively" merely means responding back and forth between 2 parties without limitation on time.

As for claims 3, 5, 41, 43, these are fairly taught on 5:50-55 wherein the consumer is assigned a unique identifier or ID code by the provider. Note that on col. 2, lines 1-5, KESEL fairly teaches use of more than one or several independent market research firms to collect consumer feedback for the provider. Therefore, if the provider wants to use more than one firms to ensure consistent results, it would have been obvious to assign a unique identifier for each independent firm or it would have been obvious in view of the general teaching of the identifier for each group above to include

an identifier for the service evaluator to monitor effectively who/what is the specific/selective service evaluator when they are several evaluators involved. .

As for claims 6, 20, 47, these are shown on Fig. 3, elements 62, 64, 66, 72 and Fig. 4, elements 90, 93. As for claims 7, 21, 33, 44, these are shown on Fig. 4 or 5 or Table 2 for selected issue.

As for claims 8-10, 23-25, 45-46, 48, which further limit the step (c ) and “may evaluate”, these claims carry no patentable weight since the term “may evaluate” as shown in claim 1 is considered as optional. Alternatively, KESEL fairly teaches the monitoring of the products and services and performance of the store, department and salesperson with detailed analysis as shown in the survey (see Tables 2, 3, Figs. 3-5 which the objective of responding to the survey to ensure consumer satisfaction and good perceptions about goods and services (see col. 1, lines 15-65). Therefore, in view of these objective, it would have been obvious for the provider to assess the performance of the at least one employee (salesperson) with the service evaluator to ensure excellent performance from salesperson (service).

As for claims 11, 22, these are taught 2: 26-31, 4:45-60, 5:40-60 wherein the report is sent directly to the management. As for claim 42, this is shown on Fig. 3, (62, 66). As for claims 13, 27, 35, 50, these are disclosed as the consumer feedback apparatus shown in Figs. 1, element 10 or 5:35-65. As for claims 14, 28, 36, 51, this is inherently in the consumer feedback apparatus of KESEL since it's automated and no manual steps are required. As for claims 15, 29, 37, 52, these are taught in 11:35-45, 6:37-42. As for claims 16, 30, 38, 53, the limitation of accessing the inquiry system by

Art Unit: 3629

means of Internet is taught on 10:47-52 wherein the provider can access the results of the survey by Internet.

7. Claims 12, 26, 34, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over KESEL.

The practice of rewarding the consumer an incentive or reward for replying to the survey is well known in the art. It would have been obvious to modify the process of KESEL by giving incentive/reward to customers who responds to survey or giving feedback for compensation of time and effort involved for responding to the survey which are critical to the success of the company as taught in col. 1, lines 15-67.

8. Claims 2, 12-16, 18, 26-30, 32, 34-38, 40, 49-53 rejected (2<sup>nd</sup>) under 35 U.S.C. 103(a) as being unpatentable over KESEL as applied to claims 1-3, 5-16, 18, 20-30, 31-38, 39-53 above, and further in view of REMLER (US 2002/0077906) or FUERST (US 6,189,029).

The teaching of KESEL is cited above. As for claims 2, 18, 32, 40, REMLER is cited to teach interactive survey to improve services and products value, image, responding speed (using Internet) , and consumer desirability (0004). It would have been obvious to modify the process of KESEL by using interactive survey as taught by REMLER to improve to improve services and products value, image, responding speed (using Internet), and consumer desirability (0004). As for claims 12, 26, 34, 49, REMLER is cited to teach well known practice of rewarding incentive to the customer for responding to a survey or giving feedback (0017, 0074). It would have been obvious to modify the process of KESEL by giving incentive/reward to customers who responds to



survey or giving feedback as taught by REMLER above as a means for compensation of time and effort involved for responding to the survey.

As for claims 13, 27, 35, 50, these are shown on Figs. 1-3 of KESEL or Fig. 1 of REMLER. As for claims 14-16, 28-30, 36-38, 51-53, these are shown on Fig. 1, 0017, 0018, 0029 of REMLER.

9. Claims 2,13-16, 18, 27-30, 32, 35-38, 40, 50-53 rejected (3<sup>rd</sup>) under 35 U.S.C. 103(a) as being unpatentable over KESEL as applied to claims 1-3, 5-16, 18, 20-30, 31-38, 39-53 above, and further in view of FUERST (US 6,189,029).

The teaching of KESEL is cited above. As for claims 2, 18, 32, 40, FUERST is cited to teach interactive survey to improve survey results speed and effectiveness (col 9, lines 20-30). It would have been obvious to modify the process of KESEL by using interactive survey as taught by FUERST to improve survey results speed and effectiveness. As for claims 12, 26, 34, 49, REMLER is cited to teach well known practice of rewarding incentive to the customer for responding to a survey or giving feedback (0017, 0074). It would have been obvious to modify the process of KESEL by giving incentive/reward to customers who responds to survey or giving feedback as taught by REMLER above as a means for compensation of time and effort involved for responding to the survey.

As for claims 13, 27, 35, 50, these are shown on Figs. 1-3 of KESEL or Fig. 1 of FUERST. As for claims 14, 28, 36, 51, these are also shown on FUERST col. 2, lines 20-25. As for claims 15-16, 29-30, 37-38, 52-53, these are also shown on FUERST col. 2, lines 25-30, col. 10, lines 10-20.

***R sponds to Arguments***

10. Applicant's arguments, see paper No. 6, filed 9/22/03, with respect to the rejection(s) of claim(s) 1-53 under FUERST have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as shown above.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. US 6,577,504 is cited to teach the use of an automatic inquiry/response system feedback (0017) to improve speed and reduce cost (col. 2, lines 25-35, 50-55) similar to FUERST above.

2. US 5,893,075 is cited to teach the use of an automatic inquiry/response system feedback with incentive to improve speed and reduce cost.

3. NPL: Article 1992 is cited to show well known use of survey to monitor performance of salesperson by conducting survey with respective customer. This is cited here for applicant's awareness and not in the rejection to avoid multiple rejections.

Art Unit: 3629

12. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
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Information Help Line	1-800-786-9199

dtn  
December 15, 2003

  
DEAN T. NGUYEN  
PRIMARY EXAMINER